#18/RESPONSE
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ATTORNEY'S DOCKET NO. A0521/7125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	James A. McKain, et al.
Serial No.:	08/932,784
Filed:	September 18, 1997
For:	MOTION PICTURE RECORDING DEVICE USING DIGITAL, COMPUTER-READABLE NON-LINEAR MEDIA
Art Unit:	2712
Examiner:	H. Nguyen

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed with the United States Postal Service as first-class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C., 20231, on the 17th day of May, 2000.

Peter J. Gordon, Registration No. 35,164
Attorney for Applicants

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE

Dear Sirs:

In response to the Office Action mailed February 17, 2000, Applicants respectfully request reconsideration. Claims 1-2 and 4-45 have been examined and remain in this application.

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Rejections Under 35 U.S.C. §103

In paragraph 2 of the Office Action, claims 1-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,946,445 (Peters) in view of U.S. Patent No. 5,109,482 (Bohrman). Applicants respectfully traverse this rejection.

The Examiner states that Peters fails to teach a motion picture camera that is mounted in a housing. The Examiner then asserts that to "combine separate parts to become an integral part is obvious in view of a practitioner in the art" and cites to In re Larson, 340 F.2d 965 (CCPA 1971). Applicants respectfully assert that the Examiner's reliance on Larson is improper.

MPEP §2144.04, which cites Larson, explicitly requires that "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rational used by the court" (emphasis added). Larson held that the act of making the brake drum and clamping means integral was not patentable over prior art which taught having a brake drum separate from the clamping means but that were secured together as a single unit. See Id. at 968. That is, "integration" as used in Larson means making two interconnected pieces that all ready exist in a prior art reference into a single piece. These facts are significantly different from those presented here.

Here, Applicants are not merely making a single integral element from two interconnected pieces of a machine but, rather, Applicants are claiming a motion picture recorder having means for receiving and storing digital still images and editing those images. Peters does not state that the video system should be integrated with a camera but, rather that the video system itself may be made portable. A portable video system as taught in Peters would still receive a signal from an external video source. Peters does not teach that a camera and a video system are integrated and contained in a single housing. In other words, unlike Larson, Applicants are not merely making integral two all ready existing pieces of Peters, rather, Applicants a putting together a video system including an editor with a camera which is not even part of Peters.

In view of the foregoing Applicants respectfully assert that the Examiner's reliance on Larson is misguided and that any rejections based thereon are improper.

The Examiner then admits Peters does not teach using an editing unit by defining a sequence of the digital still images to be played back. The Examiner asserts that Bohrman teaches a computer for editing prestored video information.

Bohrman fails to rectify the deficiency noted above. Namely, Bohrman does not teach or suggest a motion picture camera and a memory both mounted in the housing. Thus, for at least the reasons discussed above, even if one were to combine Peters and Bohrman as suggested by the Examiner, such a combination does not render obvious Applicants' claimed invention.

In addition, Applicants do not observe and the Examiner has failed to provide any evidence why one of ordinary skill in the art would be motivated to combine Peters with

Bohrman. The only statement in the Office Action is that one would combine in order to "provide convenience to the user." The Examiner is required, however, to provide clear and particular evidence of a motivation to combine references. "Conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In re Dembiczak; 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999). To provide "convenience" is a merely a conclusory statement. Thus, Applicants respectfully assert that the Examiner has not his burden with respect to the combination of Peters and Bohrman.

Furthermore, Bohrman does not teach or suggest that 1) the editing and recording systems should be part of the camera and 2) that both the editing and recording systems should operate on a digital, computer-readable and writeable random-access medium contained in the camera. With respect to the first point, the editing of Bohrman is done on a computer (col. 2, lines 27-34). Having such an editing system external to a camera is nothing more than the Applicants' admitted prior art (see Applicants' specification at page 1, lines 22-30). Bohrman is devoid of any teaching or suggestion that the editing system be implemented in a digital camera. As to the second point, Bohrman explicitly states that the editing system operates on a videodisk (col. 2, lines 14-26). As one of ordinary skill will realize, such a videodisk is created on machines separate from and not part of a digital camera. In view of the foregoing, Applicants respectfully traverse the Examiner's rejections of claims 1-2 and 4-44.

Conclusion

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. A notice to this effect is respectfully requested. Should further questions arise concerning this application, the Examiner is invited to call the Applicants' attorney at the number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed

check, please charge any deficiency to deposit account No. 23/2825.

Respectfully submitted,

JAMES A. MCKAIN, ET AL.

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Docket No. A0521/7125
Dated: May 17, 2000
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GAU 2712

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Attorney for Applicants

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith are the following documents:

[X] Response; and
[X] Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617) 720-3500, Boston, Massachusetts.

No check is enclosed or required. If the fee is insufficient, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,

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